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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,001	09/24/1999	ADEN DALE HIATT, JR.	HTT-9901	1129

7590 03/14/2002

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EXAMINER

CRAVER, CHARLES R

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 03/14/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/406,001	Applicant(s) Hiatt, Jr.	
Examiner Charles Craver	Art Unit 2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Dec 31, 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 and 13-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11 and 13-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14, 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al, of record, in view of "Import Personal Address Book (PAB) to Outlook 97" by Grant Miller.

Regarding claim 1,

Pepe discloses a system for transferring data comprising:

a portable wireless device (30, col 1 lines 36-41)

a wireless communication system (54) capable of establishing a wireless communication link with the device

a wireline network (49) connected to the wireless network (see FIG 4)

a computer (22, see FIG 1) connected to the wireline network, the computer capable of sending data to the wireless device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), the computer inherently using software. Further, since the data may be in email format (col 3 lines 48-56), it is assumed that the data may comprise any information a user wishes to transfer,

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including but not limited to text, files, or a plurality of addresses. Lastly, the computer is not a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the portable device stores the received addresses in its address database.

Miller discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (lines 1-15). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database. For a more detailed explanation of said process, see "User Profiles and Information Services" and "How to Copy the PAB to Another Computer", Microsoft publications Q162203 and Q169709.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

Regarding claim 2,

Pepe discloses that said wireless device is a cellular device (col 1 lines 36-41).

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Regarding claim 3,

As shown above, Pepe discloses applicants invention of claim 1. However, Pepe does not specifically disclose that said network operates under a digital PCS wide area network protocol. However, such a feature was well known in the art at the time of the invention, as evidenced by the teachings of LaDue, where it is stated that PCS, a wide area network by definition, falls under the wide definition of “cellular” (col 6 lines 11-20); as such the examiner takes Official Notice of such a feature. It would have been obvious, noting Pepe’s disclosure that the user may comprise a cellular terminal, that such a memory transfer method may be applied to a PCS wide area network, as it would allow the invention of Pepe to operate on new communication systems and standards.

Regarding claim 4,

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe does not specifically recite that said network may operate according to a hypertext protocol. However, given that Pepe does disclose thus use of internet and email protocol (col 5 lines 5-13), it would have been obvious to one skilled in the art at the time of the invention to utilize HTTP as it is a common internet protocol for transferring data, as evidenced by the teachings of Kotola, where it is stated that HTTP is a form of internet protocol (col 1 lines 24-43, col 3 lines 5-16); as such, since HTTP is a form of internet protocol, as taught by Kotola, the internet protocol of Pepe would obviously include HTTP.

Regarding claim 5,

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Pepe teaches that the invention may utilize the internet (col 23 lines 40-46) and uses email as a messaging standard (col 3 lines 48-56, col 11 lines 3-6).

Regarding claims 6-9,

Pepe discloses a PDA which would inherently contain a program for selecting and transferring the data, as would Outlook. As for claims 7-9, since Pepe teaches a PDA which may send email to the computer (col 10 line 63-col 11 line 6), a situation in which a PDA user sends an email using said software requesting, for example, a telephone number, file, or selected addresses would read on claims 7-9.

Regarding claim 10,

Pepe discloses a method for transferring information comprising at a first electronic device (computer 22, see FIG 1) connected to a combined wireline (54) and wireless (49) network (FIG 4), setting up a communication path between it and a second device (30) connected to said networks (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using transfer software to do so and using or entering an address of said second device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), and sending said data, which may be in email format (col 3 lines 48-56); given such a format, it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer and device are not specifically a part of the wireline or wireless networks (see FIGS 1 and 4).

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Pepe does not specifically disclose that the portable device and the computer have address databases, and that the data is moved from the first address book to the second.

Miller discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (lines 1-17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

Regarding claim 11,

Pepe discloses that the communication can be bi-directional (see FIG 1).

Regarding claims 13 and 14,

Miller disclose that said addresses may be in a file (lines 1-10), and as such selection of a field in the file would further have been obvious to one of ordinary skill in the art as it would not part from the scope of the teachings of Pepe in view of Miller.

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Regarding claim 16,

Since the second device of the invention of Pepe is in part a cellular telephone (col 5 lines 5-30), it is inherent that it would be identified by its telephone number when a data request message is to be sent to it via said messaging protocols.

Regarding claim 18,

Pepe discloses a method for transferring information from a computer (22, see FIG 1) inherently using a program, comprising at said first electronic device, connected to a network (FIG 4), setting up a communication path between it and a second device (30) connected to said network (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using/displaying transfer software to do so and using or entering or requesting an address of said second device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), and sending said data, which may be in email format (col 3 lines 48-56); given such a format, it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer and device are not specifically a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the data is moved from the first address book to the second and stored there.

Miller discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information

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from a file (receivable from e.g. an email) and insert it into their address database (lines 1-17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

Regarding claims 19 and 20,

Miller discloses that said addresses may be in a file (lines 1-10), and as such selection of a field in the file would further have been obvious to one of ordinary skill in the art as it would not part from the scope of the teachings of Pepe in view of Miller.

3. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in view of Miller as applied to claim 10 above, and further in view of Günlük, of record.

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe in view of Miller does not specifically recite that said network may operate according to a hypertext (i.e. internet) protocol or an electronic mail protocol such that a URL or E-mail address is entered rather than a phone number to contact the wireless device.

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Günlük discloses that it is useful in a wireless messaging system using, for example, SMS, to allow interoperability, that is, to operate the network such that SMS and other such messaging protocols may be translated into other protocols for messaging interoperability, said other protocols including electronic mail and TCP/IP (i.e. hypertext) (see FIG 2, col 3 lines 55-67). Therefore, it would have been obvious to one skilled in the art to add such a feature to Pepe in view of Miller as it would offer a higher performance message routing method, and thus allow better access to the information present in the wireless device.

Response to Arguments

4. Applicant's arguments filed 12-31-01 have been fully considered but they are not persuasive.

First, regarding claims 1 and 10, while claims 1 and 10 recite a "personal communication device", which is defined in the specification as limited to a PDA, cellular phone, etc., such a limitation is quite broad, and the broadest reasonable interpretation of such a limitation would still lead one of ordinary skill in the art to the utilization of a notebook computer such as that taught by Pepe; the applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Gruens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It should be also noted that Pepe describes a "PDA" as a notebook computer connected wirelessly to the network.

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Further, while Outlook stores a new .pab file, the first claim does not specifically teach away from such a system. Rather, in a case where Outlook receives a .pab file and stores it when there is no .pab file present, such a method would account for a stored set of data in a database (i.e. Outlook's allocated memory).

Regarding claims 3 and 4, the examiner has provided references showing the obviousness of a PCS network and HTTP, as shown above.

Regarding claims 8 and 9, the inherent process of utilizing a file name in the extraction of an entire file using the software would be a portion of said program. While the applicant states that Outlook could not be the transfer program, there is no support for such an assertion, and given that the notebook computer of Pepe would have been able to run Outlook, it may be read as the file transfer program, which would further allow the user to select the file to be extracted (using a filename and field).

Regarding claim 11, since Pepe shows bidirectional communication, there is no specific need for Miller to describe such a communication; Miller is merely used to disclose the obvious modification of using Microsoft Outlook on a desktop and notebook computer, a software program utilized by millions of people around the world on a daily basis.

Regarding claims 14 and 20, the limitation of claims 14 and 20 recites a selection of a field, but said field is not disclosed as having any other purpose. As was well known at the time of the invention, Outlook 97 allowed a user to highlight and copy portions (i.e. 'fields') in an

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email. As such, the selection of such data would be allowable using the combined invention of Pepe in view of Miller.

Regarding claim 18,

The selection of an option to utilize the method of Pepe in view of Miller, as stated above in the rejection of claim 18, would have been inherent, in order to enable the user to actually perform the process of sending a message. Such a step is inherent in any messaging system (email, SMS, etc) where the user is allowed to specify a message to be sent. An example of this is in Outlook, where an email is sent after the user clicks on the 'send' button.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kotola et al discusses the use of internet protocols in messaging systems.

LaDue discusses the use of PCS networks in cellular systems.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

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CC
C. Craver
March 6, 2002

edward f. urban
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